REMARKS

Applicant would like to thank the Examiner for the personal interview conducted on August 21, 2003, and for his consideration of the informally submitted response and prior art references. The present response formalizes those materials in accordance with the agreement reached during the interview.

In the office action mailed June 18, 2003, Claims 1-45 were pending for consideration. Of these, Claims 1, 17, 18, and 31-40 were rejected under the judicially created doctrine of obviousness-type double patenting in view of Claims 33, 34, and 42 as contained in U.S. Patent 6,286,498. Further, Claims 2-16, and 19-30 were objected to as depending on a rejected base claim, and Claims 41-45 were allowed.

Applicant would like to take this opportunity to bring to the Examiner's attention a reexamination proceeding that has been granted with respect to U.S. Patent 6,286,498 (hereinafter "'498 patent"). The reexamination proceeding has been assigned serial no. 90/006,413.

In response to the obviousness-type double patenting rejection, Applicant encloses herewith a terminal disclaimer compliant with the provisions of 37 CFR § 1.321(c). As noted in the office action, 37 CFR § 1.130(b) prescribes the timely filing of a terminal disclaimer for overcoming an obviousness-type double patenting rejection. However, it should be noted that such terminal disclaimer is only filed for the purposes of facilitating allowance of the present claims.

Applicant submits that Claim 1 of the present application is patentably distinct from Claim 33 of the '498 patent. Specifically, Claim 1 of the present application reads as follows:

1. A method of making a superabrasive impregnated tool comprising the steps of:

a) providing a matrix support material;

b) locating a plurality of superabrasive particles at individually specified positions on a top surface of the matrix support material according to a predetermined pattern; and

c) bonding the superabrasive particles to the matrix support material.

In the office action, the Examiner has noted some of the differences between Claim 33 of the '498 patent and Claim 1 of the present application. Specifically, the Examiner has noted the absence of the "positively" planted language, and of the metal matrix element in present Claim 1. However, the Examiner justifies such deficiency by concluding that the superabrasive particles of Claim 1 must be positively planted in the matrix support material, and that it would be obvious as a matter of choice to one of ordinary skill in the art, to use a metal for the matrix support material, as such are well known.

Applicant does not take issue with the Examiner's position on either of the above recited points, but does believe that the Examiner has failed to fully appreciate the meaning of the term "bonding" as recited in element (c) of Claim 1. Specifically, as used in the context of connecting superabrasive particles to a matrix support material, or substrate, the term "bonding" means "chemically bonding". Support for such an interpretation is found in the specification, *inter alia*, on pg. 2, ln. 10-15; pg. 9, ln. 12-17; pg. 11, ln. 8-11; pg. 14, ln. 4-9; pg. 16, ln. 19-pg. 17, ln. 5; pg. 20, ln. 14-17; pg. 21, ln. 10-20; pg. 25, ln. 21-pg. 26, ln. 2; pg. 29, ln. 2-7; pg. 39, ln. 1-10; pg. 41, ln. 4-6; and pg 44, ln. 1-8. Neither Claim 33, nor any of the other claims of the '498 patent include a chemical bonding element. Applicant therefore submits that Claim 1 of the present application is patentably distinct therefrom.

In any case, Applicant submits that the filing of the enclosed terminal disclaimer overcomes the rejection of claim 1, 17, 18, and 31-40. Accordingly, Applicant also submits that the Examiner's objection to Claims 1-16, and 19-30 is also overcome.

CONCLUSION

In view of the foregoing, Applicant respectfully submits that the pending Claims 1-45 are in condition for allowance, and early allowance thereof is respectfully requested. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be overcome during a telephone interview, the Examiner is invited to telephone Mr. David Osborne, or in his absence, the undersigned attorney at (801) 566-6633, so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 20-0100.

Dated this 25th day of August, 2003.

Respectfully submitted,

THORPE, NORTH & WESTERN, LLP

M. Wayne Western
Reg. No. 22,788
8180 South 700 East, Suite 200
Sandy, UT 84070
Telephone: (801) 566-6633
Facsimile: (801) 566-0750